IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Alejandro Wiechers

Serial No.: 10/635,437

Filed: August 7, 2003

Group Art Unit: 2625

Examiner: Singh, Satwant

Docket No. 200207446-1

For: **Method of Performing Automated Packaging and Managing Workflow In a Commercial Printing Environment**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed July 11, 2008 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to points made in Applicant's Appeal Brief. Applicant addresses those responses in the following.

1. No Description of Actions Performed at a "Designer Location"

As noted in Applicant's Appeal Brief, Hansen does not describe actions that are performed at a "designer location". Instead, Hansen's disclosure focuses on actions performed at a "print shop." Therefore, the various actions disclosed by Hansen and identified by the Examiner as anticipating several of Applicant's claims limitations that specify actions that are performed at a "designer location" do not in fact occur at a designer location. Instead, they occur at a print service provider location (i.e., Hansen's print shop).

On page 10 of the Examiner's Answer, the Examiner now cites column 6, lines 51-67 of the Hansen reference for support of the argument that Hansen's disclosure describes actions performed at a designer location. That portion of Hansen's disclosure provides:

> The job preparation workstations 116 also provide the capability of the print shop to add value to the print production process by offering services to the customer. Such services include the ability to modify documents provided by the customer to add features that the customer could not or would not add himself. Such features include adding page numbers across multiple documents, bates numbering, adjusting page layout for tab stock and aligning the output to account for binding. Further the job preparation stations 114 provide the capability to fix errors in the documents such as removing artifacts in scanned images and masking over

> unwanted text or markings. The job preparation stations 114 can also be used to prevent inaccuracies in the finished output caused by the printing or binding process. Such inaccuracies include binder's creep which happens after a document is imposed into a booklet/pamphlet using a signature imposition.

Hansen, column 6, lines 51-67. As can be readily appreciated from that excerpt, Hansen explicitly states that the job preparation workstations 116 are located at a printer shop. Despite that, the Examiner states that he is interpreting the job preparation stations as designer locations. In particular, the Examiner states that "just because the job preparation stations are located in the print shop, does not mean that it [*sic*] is not a designer location." *Examiner's Answer*, page 10.

In reply, Applicant submits that the Examiner's position not only defies logic but is nonsensical. In essence, the Examiner is arguing that a workstation, which is admittedly located in a print shop (i.e., a print service provider location), is a designer location. In all honesty, Applicant finds it difficult to even comprehend how the Examiner could arrive at such a conclusion. Unfortunately, the Examiner provides little explanation to support that conclusion. Regardless, Applicant reiterates that if a workstation is located at a print service provider location, it cannot properly be regarded as being located at a designer location, barring a situation in which the designer is also the print service provider. As noted in the Appeal Brief, Hansen provides no such indication.

2. No Teaching of "Real Time Configuration Information"

As was also noted in the Appeal Brief, Hansen does not teach "receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location". First, as described above, Hansen does not describe actions that are performed at any "designer location" and instead limits his disclosure to attributes of a print shop. Second, even if one were to, as the Examiner has, interpret the job preparation stations 116 as designer locations, Hansen *still* fails to teach such a location receiving "real time configuration information regarding a print production device at the print service provider location". Indeed, Hansen does not say anything about "real time configuration information," whether it be about a "print production device" or another component of Hansen's system.

On page 11 of the Examiner's Answer, the Examiner reiterates his position that column 7, line 63 to column 8, line 6 teaches Applicant's claimed "receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location". The cited section of Hansen's disclosure provides:

> The print server application offers the user interface ability to configure and manage the print server operation. These processes include spooling and queuing jobs and job content (i.e. the document), directing the jobs to specific production output devices based on the attributes of the print job and how these attributes are satisfied by the print engine, load balancing jobs among the various production output devices to keep all printers fully utilized, e.g. to split color from black and white jobs, and acting as a communication gateway where it can accept multiple input communication

> and print protocols translating them to the communication and print protocol the production output device 122 understands.

Hansen, column 7, line 63 to column 8, line 6. As can be appreciated from that excerpt, while Hansen discusses various actions such as spooling and queuing jobs and directing the jobs to output devices that can process them, Hansen says nothing whatsoever about "real time configuration information regarding a print production device". Therefore, Hansen does not explicitly teach "receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location". Moreover, Hansen does inherently teach that action, given that nothing in Hansen's disclosure inherently requires such an action. As expressed by the Federal Circuit:

> Under the principles of inherency, if the prior art *necessarily functions* in accordance with, or includes, the claimed limitations, it anticipates.

Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 51 USPQ2d 1943 (Fed. Cir. 1999) (emphasis added). Regarding Hansen's disclosure of "load balancing," such balancing could comprise simply directing jobs so that each output device processes roughly the same number of jobs or the same number of pages. Therefore, there is no reason to presume that such load balancing necessarily involves receiving real time information from those devices.

In addition, the Examiner cites, for the first time in prosecution of the present application, column 13, lines 4-10, which provide:

> The workflow management software supports standard interfaces and protocols to production output devices and print servers. Further, tools are provided for managing, selecting and monitoring multiple production output devices. These tools provide visual feed back of each of the devices status to the user such as the current job queues.

Hansen, column 13, lines 4-10. Like the other excerpt, the above excerpt is silent as to receiving real time configuration information regarding a print production device. Furthermore, the mere mention of "standard interfaces" that provide feedback as to the "status" of "job queues" is not "real time configuration information regarding a print production device". First, "status" information concerning the job queue is not "configuration information" about a print production device. Second, the term "real time" denotes the substantially instantaneous transfer of information as conditions change. There is simply no reason to presume that the status information in Hansen's disclosure is conveyed in that manner.

3. No Teaching of "Packaging Instructions" or "Packaging" for Shipment

Applicant further noted in the Appeal Brief that Hansen does not teach "generating at the designer location packaging instructions that describe how the printed output is to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information" or "packaging the printed output at the print service provider location in accordance with the packaging instructions contained

within the high performance file". Again, Hansen does not describe actions that occur at any "designer location" and instead limits his disclosure to attributes of a print shop. Furthermore, Hansen *does not even discuss* packaging documents for shipment.

On page 12 of the Examiner's Answer, the Examiner reiterated his position that Hansen's mention of "finishing, such as stapling or binding" is a disclosure of packaging for shipment. In reply, Applicant reiterates that a teaching of finishing, such as stapling or binding, is *not* a teaching of packaging for shipment. As noted previously, 35 U.S.C. § 102 requires that a reference explicitly or inherently teach each and every claim limitation. Although the Examiner may hypothesize that "finishing" *could* include packaging for shipment, that is simply not enough for a proper rejection under Section 102. Moreover, the argument that binding is packaging for shipment is nonsensical. Clearly, a printed document is not "packaged for shipment" simply by virtue of it being bound. For example, one would not regard a booklet as being packaged for shipment just by virtue of the fact that the pages of the booklet are bound together.

4. No File that "Contains the Digital File and the Packaging Instructions"

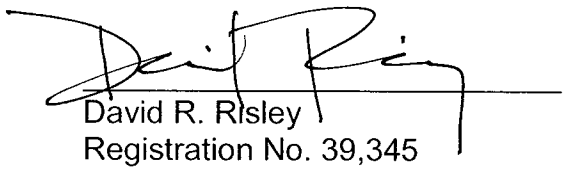
Applicant also noted in the Appeal Brief that Hansen does not teach "creating at the designer location a high performance file that contains the digital file and the packaging instructions". Again, Hansen does not describe actions that occur at any "designer location" and instead limits his disclosure to attributes of a print shop. Moreover, Hansen fails to teach creating a high performance file that contains a digital file and "packaging instructions". Again, Hansen is silent as packaging for shipment. It logically follows then that Hansen does not teach creating a file that contains packaging instructions.

On page 12 of the Examiner's Answer, the Examiner appears to argue that Hansen's disclosure of "finishing" is tantamount to a teaching of "creating at the designer location a high performance file that contains the digital file and the packaging instructions". In reply, Applicant notes that even if one took the Examiner's view that finishing inherently requires packaging, Hansen's mention of finishing *still* would not comprise a teaching of creating a file that includes "packaging instructions".

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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